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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|-------------------------------|--|
| <b>Proceeding</b>             | 91153683   |
| <b>Party</b>                  | Plaintiff<br>UNIVERSAL CITY STUDIOS, INC.  |
| <b>Correspondence Address</b> | CHISTOPHER C. LARKIN<br>SEYFARTH SHAW<br>2029 CENTURY PARK EAST SUITE 3300<br>LOS ANGELES, CA 90067-3063 |
| <b>Submission</b>             | OPPOSER'S REPLY BRIEF ON ITS MOTION FOR LEAVE TO<br>FILE A FIRST AMENDED NOTICE OF OPPOSITION            |
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| <b>Date</b>                   | 04/23/2004   |
| <b>Attachments</b>            | 2004-04-23 Opposer's Reply Brief.pdf ( 6 pages )   |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 76/295,515  
Published in the Official Gazette of June 18, 2002

UNIVERSAL CITY STUDIOS LLLP,

Opposer,

v.

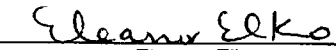
VALEN BROST,

Applicant.

Opposition No. 153,683

**CERTIFICATE OF ONLINE FILING**

I hereby certify that on April 23, 2004, this paper is being filed online with the U.S. Patent and Trademark Office before the Trademark Trial and Appeal Board .

  
Eleanor Elko

**OPPOSER'S REPLY BRIEF ON ITS MOTION FOR LEAVE TO FILE A FIRST  
AMENDED NOTICE OF OPPOSITION<sup>1</sup>**

**INTRODUCTION**

Applicant's opposition to Opposer's motion to amend is full of generalities and hyperbole, but completely devoid of any concrete reasons for denial. Applicant concedes that this motion was not brought in bad faith and that the proposed amendments are legally sufficient, and claims only that Opposer unduly delayed in raising the new claims and that he would be prejudiced if forced to defend against them after the close of discovery. But he makes no effort to identify what discovery he could conceivably need to address issues regarding his own acts and state of mind, or how such discovery would enable him to defend against claims based solely upon his own testimony and documents. Because Applicant's own admissions show that he is not entitled to registration for all of the reasons that Opposer seeks to assert by amendment,

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<sup>1</sup>Because this reply brief responds to and clarifies the issues of delay and prejudice raised in Applicant's opposition, Opposer respectfully requests that the Board consider it on this motion. *Trek Bicycle Corp. v. Style Trek Ltd.*, 64 USPQ2d 1540, n. 2 (TTAB 2001).

Opposer's motion to amend should be granted and the Board should grant Opposer's related motion for summary judgment.

## **ARGUMENT**

### **THE BOARD SHOULD GRANT OPPOSER LEAVE TO AMEND.**

Applicant completely ignores the settled law that “amendments to pleadings should be allowed with great liberality at any stage in the proceeding where necessary to bring about a furtherance of justice unless it is shown that entry of the amendment would violate settled law or be prejudicial to the rights of any opposing parties’.” *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993) (quoting *American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471, 473 (TTAB 1971)); see *Trek*, 64 USPQ2d at 1541. Applicant concedes that the proposed amendments would not violate settled law, so the only issue is whether they would prejudice Applicant. As shown below, there is no conceivable prejudice to Applicant, and Opposer should be granted leave to amend.

#### **A. There Was No Undue Delay in Seeking Leave to Amend.**

The issue of undue delay in seeking to amend a pleading turns on the length of the delay in seeking leave to amend after learning the facts supporting the amendment, *Trek*, 64 USPQ2d at 1541, and “is inextricably linked with the concept of prejudice to the non-moving party.” *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1359 (TTAB 1989)

Opposer conducted the discovery deposition of Applicant after the close of discovery to accommodate the schedules of Applicant and his counsel. That deposition yielded detailed testimonial admissions supporting the addition of the three new grounds for opposition and, indeed, establishing the existence of undisputed facts justifying the entry of summary judgment on those grounds. Applicant does not dispute that Opposer moved to amend promptly after receiving the transcript of Applicant's deposition through which the facts supporting the

amendments were learned.<sup>2</sup> A delay of about two weeks in moving to amend is clearly not an “undue” delay. *Cf. Trek*, 64 USPQ2d at 1541 (undue delay found where opposer waited nine months to seek to amend notice of opposition where the proposed amendment “appear[ed] to be based on facts within opposer’s knowledge at the time it filed the notice of opposition”).

**B. There is No Substantial Prejudice to Applicant Through Amendment.**

Applicant variously claims that a “discovery extension would be required to accommodate Opposer’s amendments [and] failure to extend discovery would severely prejudice Applicant,” that “[t]he additional claims will require a line of discovery that would unnecessarily cause undue delay in this matter,” and that “[i]f Applicant had known of Opposer’s claims . . . during the discovery period, Applicant could have taken substantive discovery on these issues and subpoenaed relevant documents for his defense.” Opp. at 2-3.<sup>3</sup> But Applicant makes no effort whatsoever to identify what discovery and documents would be needed to support his “new defenses,” much less how such discovery would be relevant to the claims sought to be added by amendment.

There is an obvious reason. The non-use, ownership, and fraud issues to be added by amendment all involve Applicant’s own conduct and state of mind, matters which, by definition, are all uniquely and solely within Applicant’s *own* knowledge. It is self-evident that neither

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<sup>2</sup>Applicant cites no authority for his suggestion that Opposer was required to probe these issues in its written discovery requests at the risk of being penalized for learning the facts supporting the proposed amendments for the first time through a discovery deposition. Moreover, the detailed facts supporting the new claims, particularly the fraud claim, were uniquely susceptible to development through interrogation of Applicant.

<sup>3</sup>Applicant also argues that the “proposed amendments will cause substantial delay to this proceeding.” Opp. at 3. This claim sits ill in Applicant’s mouth given that Applicant has agreed, in a stipulation filed with the Board on April 16, 2004, to a suspension of this opposition pending the Board’s disposition of Opposer’s motions. If Opposer’s motion for summary judgment is denied, the case will proceed to trial on a resumed trial schedule consented to by Applicant himself.

Opposer nor any third party has any relevant information or documents regarding whether Applicant used the mark in commerce prior to filing the application, whether Applicant was and is the owner of the “UNIVERSAL TOYS” mark, and whether Applicant’s representations to the Patent and Trademark Office in the opposed application were fraudulent. As the Board put it at page 6 in its October 15, 2003 order rejecting Applicant’s Rule 56(f) request to take discovery to defend Opposer’s motion to strike Applicant’s equitable defenses, “applicant does not require . . . discovery from opposer [because] Applicant already possesses the information he requires,” in the form of his own testimony and documents, to defend the claims sought to be added by amendment.

Because no discovery is needed by Applicant to respond to the new claims, there is no conceivable prejudice to Applicant from granting Opposer leave to assert them after the close of discovery. *See Metromedia Steakhouses Inc. v. Pondco II Inc.*, 28 USPQ2d 1205, 1206-07 (TTAB 1993) (amendment of notice of opposition allowed after close of discovery where “additional discovery as to the ground sought to be added to the plaintiff’s claim should not be necessary” because the relevant facts “would appear to be readily established by the record, and in any event, they would surely be known to applicant”); *Alberto-Culver Co. v. F.D.C. Wholesale Corp.*, 3 USPQ2d 1460, 1462 (TTAB 1987) (applicant’s motion to assert counterclaim for abandonment granted where “opposer should not need additional discovery relating to the counterclaim since all facts relating to the alleged abandonment are within opposer’s own knowledge”); *see also DAK Indus., Inc. v. Daiichi Kosho Co. Ltd.*, 25 USPQ2d 1622, 1625 (TTAB 1993) (discovery from opposer unnecessary where relevant facts regarding applicant’s state of mind “would necessarily be known to applicant”).

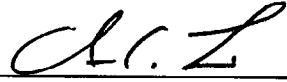
**CONCLUSION**

For all of the foregoing reasons and for the reasons set forth in Opposer's opening brief, Opposer's motion to amend should be granted in its entirety.

Dated: April 23, 2004

Respectfully submitted,

SEYFARTH SHAW LLP

By: 

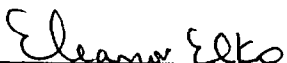
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**CERTIFICATE OF SERVICE**

I hereby certify that on April 23, 2004, I served the foregoing Opposer's Reply Brief on Its Motion for Leave to File a First Amended Notice of Opposition on the applicant by depositing a true copy thereof in a sealed envelope, postage prepaid, in First-Class U.S. mail addressed to applicant's counsel as follows:

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Eleanor Elko